

P20739.A05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ronald John VEITCH et al.

Group Art Unit : 1774

AETJ
8/3/03

Appln. No : 09/826,932

Examiner : Ahmed

Filed : April 6, 2001

For : MAGNETIC RECORDING MEDIUM

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Sir:

This is in response to the requirement for restriction under 35 U.S.C. 121 mailed from the U.S. Patent and Trademark Office on February 12, 2003, which sets a one month shortened statutory period for response until March 12, 2003.

Applicants note that this response is being submitted by the initial due date of March 12, 2003, whereby an extension of time and an extension of time fee are not required for maintaining the pendency of the application. However, if any government fees are required for maintaining the pendency of this application, including any extension of time fees, this response expressly requests and authorizes that any such required fee be charged to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:

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Restriction Requirement

The Examiner has required restriction to one of the following inventions under 35 U.S.C. 121:

I. Claims 1-23 and 26, drawn to a magnetic recording medium, classified in class 428, subclass 336+.

II. Claims 24 and 25, drawn to a process for making a magnetic recording medium, classified in class 427, subclass 457+.

Election

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group I, claims 1-23 and 26, with traverse.

Traverse

Notwithstanding the election of the claims of Group I in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the Examiner's requirement for restriction.

Initially, it is noted that the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as set forth in MPEP 803, viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned

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omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Related to this, the requirement is traversed since there would not appear to be a serious burden to examine Applicants' application in total, and for which the appropriate claim fees have been paid. Applicants submit that it would be no serious burden on the Examiner to examine all of the pending claims, because a search for all of the claims in the above-identified application, should be made in order to do a complete and thorough search in view of the recognized relationship between the claims in Groups I and II, as stated in the Office Action.

Furthermore, as the Examiner appreciates, in order to justify a requirement for restriction the difference between the invention defined by the various groups of claims must be material. However, the differences pointed out in the requirement do not appear to be material for examination purposes.

It is noted that the claims of Group I are directed, as recited in independent claim 1, to a multilayer magnetic recording medium which comprises, on a nonmagnetic substrate, at least one upper binder-containing magnetic recording layer which has a thickness of less than $0.5\ \mu\text{m}$ and contains finely divided magnetic pigment having a coercive force H_c of 80 - 250 kA/m, and at least one lower binder-containing layer which contains an isotropic magnetically soft pigment which is selected from $\gamma\text{-Fe}_2\text{O}_3$, Fe_3O_4 and a solid solution of these components, the coercive force H_c of the lower layer being less than 4 kA/m and the anhysteretic susceptibility of the lower layer at 2 kA/m being greater than 7. Similarly, claims 24 and 25 are directed to processes which include on a nonmagnetic substrate, at least one upper binder-containing magnetic recording

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layer which has a thickness of less than $0.5 \mu\text{m}$ and contains finely divided magnetic pigment having a coercive force H_c of 80 - 250 kA/m, and at least one lower binder-containing layer which contains an isotropic magnetically soft pigment which is selected from $\gamma\text{-Fe}_2\text{O}_3$, Fe_3O_4 and a solid solution of these components, the coercive force H_c of the lower layer being less than 4 kA/m and the anhysteretic susceptibility of the lower layer at 2 kA/m being greater than 7. Accordingly, there should not be an undue burden to examine both Groups of claims.

In any event, even if the restriction is maintained, upon allowance of the claims of Group I, the non-elected claims of Group II should be rejoined and allowed with the elected claims.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper and should be withdrawn.

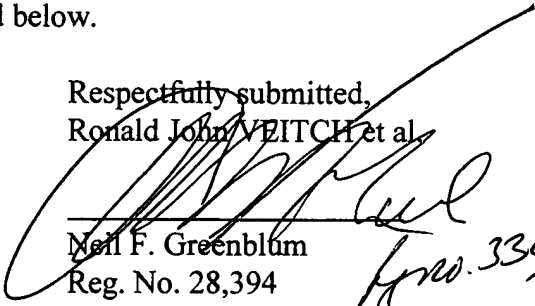
Withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested.

Favorable consideration with early allowance of the pending claims is most earnestly requested.

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If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully submitted,
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March 12, 2003
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